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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/559,804	12/07/2005	Christof Maisch	LA-7688-102/105126-40	1047
167 7590 05/28/2008 FULBRIGHT AND JAWORSKI LLP 555 S. FLOWER STREET, 41ST FLOOR LOS ANGELES, CA 90071				
EXAMINER				
WINDELL, MARK R				
ART UNIT		PAPER NUMBER		
3635				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/559,804

Applicant(s)

MAISCH ET AL.

Examiner

MARK R. WENDELL

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "in corresponding manner" is vague and indefinite and the examiner cannot ascertain the actual position of the structure with this overly broad description. For examination purposes, the examiner, from the drawings, will assume it mean opposite.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-19, 21-22, 26-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downing, Jr. (US 3271920) in view of Chicago (WO 97/12101). Regarding claims 1 and 2, Downing illustrates in Figure 1 a profile rail for the support of panel-like elements (7), comprising:

- A base body (10) that is formed at least regionally as a T section and that includes an elongate web (16) as well as a bottom chord (19), which is

arranged along a longitudinal edge of the web (16) and includes two bottom chord sections (21, 22), each of which extend from the web (16) substantially in opposite directions, with the bottom chord (19) comprising:

- A bent-over portion of the web (16) wherein a plurality of apertures (see apertures in 16 in Figure 1) are formed in the web (16), at least one of the bottom chord sections (21) comprises material sections of the web (16) folded out of the apertures and the web (16) is essentially made in one layer over its total area.

Downing does not illustrate a screening strip disposed on the bottom chord; however Chicago illustrates in Figure 2 a screening strip (see bottom edge) on the bottom chord. It would have been obvious to one having ordinary skill in the art at the time of invention to include a screening strip to the bottom chord in order to provide a rigid stabilizer or for safety purposes.

Regarding claim 3, Downing illustrates in Figure 1 both bottom chord sections (21 and 22) respectively alternating and comprising regionally material sections of the web folded out of the apertures (22) and one-piece bent-over portions of the web (21) adjoining them, with each one-piece bent-over portion of the one bottom chord section lying opposite to a material section of the other bottom chord section.

Regarding claims 4 and 5, Downing illustrates in Figure 4 the apertures, which are rectangular, each having a straight edge (bottom edge if view in Figure 1) extending parallel to the longitudinal edge of the web (16).

Regarding claims 6 and 7, Downing illustrates in Figure 1 the outer edges of the two bottom chord sections (21 and 22) extending parallel to one another and the chord sections are substantially the same width.

Regarding claim 8, Downing illustrates in Figure 1 the bottom chord (19) and the web (16) substantially perpendicular to one another.

Regarding claims 9 and 12, it is described above what is disclosed by Downing in view of Chicago; however the references do not distinctly give measurements for the radius of the bent-over portion or the thickness of the web and chords. The applicant fails to provide criticality for the distinct measurements given within the claims and it would have been obvious to one having ordinary skill in the art at the time of invention to have the specific measurements for the radius, web and chord since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art (*In re Boesch*, 617 F. 2d 272, 205 USPQ 215). The examiner also notes that the variability of the actual specific measurement values within the claim lends credence to the fact that the specific dimensions are not in fact critical to the viability of the invention.

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Regarding claim 10, Downing illustrates in Figure 1 the base body made from one, seamless strip of material. Downing also mentions in Column 2 the structure made from section metal which is a form of sheet metal (which by definition is metal formed into thin, flat sections).

Regarding claim 11, Downing illustrates in Figure 1 the web (16) being flat.

Regarding claim 13, Chicago illustrates in Figure 2 the screening strips engaging the longitudinal edges of the bottom chord members.

Regarding claim 14, Downing illustrates in Figure 1 a top chord (10-14) provided at the longitudinal edge of the web opposite the bottom chord.

Regarding claim 15, Downing illustrates in Figure 3 the top chord (10-14) coupled to fastening elements (41 and 33).

Regarding claim 16, the top chord (10-14) of Downing is a hollow section as can be seen in Figures 1 and 3.

Regarding claim 17, Downing illustrates in Figure 1 the top chord (10-14) disposed opposite the bottom chord.

Regarding claim 18, Downing illustrates in Figure 1 the top chord (10-14) having a longitudinal edge (12) connected to the web (16).

Regarding claim 19, the references do not distinctly claim the top chord being connected to the web via stitching. However, the web and top chord are connected as described above. Various methods of attaching metal objects together are well known within the art including stitching, which is generally done with wire staples.

Regarding claims 21 and 22, Downing illustrates in Figure 1 the apertures having the same width in the longitudinal direction of the web (16). Downing also illustrates the apertures in the longitudinal direction of the web having the same width as the material sections (22).

Regarding claims 26-32, Downing in view of Chicago illustrates and describes the structure of the invention and the method of producing the structure would be obvious given this structure.

Claims 20 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downing, Jr. (US 3271920) in view of Chicago (WO 97/12101) as applied to claim 1 above, and further in view of Lalonde et al. (US 5761868). It is described above what is disclosed by Downing in view of Chicago, however regarding claims 20 and 23-24 the references do not teach additional fastening apertures, or reinforcement beads (18),

formed in the web. LaLonde illustrates in Figure 1 additional fastening apertures (apertures on the side of 18). Downing, Chicago and LaLonde all refer to profile connector rails and it would have been obvious to one having ordinary skill in the art at the time of invention to include additional apertures, or reinforcement beads in between the apertures, in the web of Downing in view of Chicago in order to facilitate more interconnecting support members for utilities.

Regarding claim 25, neither Downing, Chicago nor LaLonde teach two reinforcement elements disposed between two apertures in the web. However, it would have been obvious to one having ordinary skill in the art at the time of invention to have additional reinforcement elements or beads between two apertures in the web since it has been held that rearranging parts of an invention (without compromising the structural integrity) involves only routine skill in the art (*In re Japikse*, 86 USPQ 70). The examiner further notes that adding additional apertures or beads would be obvious based on the size of the rail that is necessary.

Response to Arguments

Applicant's arguments with respect to claims 1-32 have been considered but are moot in view of the new ground(s) of rejection. The amendment of claims 1 overcomes the product by process rejection and further adds structure to the invention and therefore a new ground of rejection was necessary.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **MARK R. WENDELL** whose telephone number is (571)270-3245. The examiner can normally be reached on Mon-Fri, 7:30AM-5PM, Alt. Fri off, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571) 272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Richard E. Chilcot/
Supervisory Patent Examiner, Art
Unit 3635

/M. R. W./
Examiner, Art Unit 3635
May 22, 2008